## AMENDMENT AND RESPONSE UNDER 37 CFR 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/768,976 Filing Date: January 30, 2004

Title: COVALENT TETHERING OF FUNCTIONAL GROUPS TO PROTEINS

## IN THE CLAIMS

Please amend the claims as follows.

## 1-34. (Canceled)

- 35. (Withdrawn, Currently Amended) A method to detect or determine the presence or amount of a mutant hydrolase, comprising:
- a) contacting a mutant hydrolase with a hydrolase substrate which comprises one or more functional groups, wherein the mutant hydrolase comprises at least one amino acid substitution relative to a corresponding wild-type hydrolase, wherein the at least one amino acid substitution results in the mutant hydrolase forming a bond with the substrate which is more stable than the bond formed between the corresponding wild-type hydrolase and the substrate, wherein the at least one amino acid substitution in the mutant hydrolase is a substitution at an amino acid residue in the corresponding wild-type hydrolase that is associated with activating a water molecule which cleaves the bond formed between the corresponding wild-type hydrolase and the substrate or at an amino acid residue in the corresponding wild-type hydrolase that forms an ester intermediate with the substrate, wherein the wild-type hydrolase is a dehalogenase, wherein the mutant hydrolase is a mutant dehalogenase, and wherein the substrate is a compound of formula (I): linker R-linker-A-X, wherein the linker is a divalent branched or unbranched carbon chain comprising from about 2 to about 30 carbon atoms, which chain optionally includes one or more double or triple bonds, and which chain is optionally substituted with one or more hydroxy or oxo (=O) groups, wherein one or more of the carbon atoms in the chain is optionally replaced with a non-peroxide -O-, -S- or -NH-, wherein the linker-A separates R and X by at least 11 atoms, wherein A-X is a substrate for a dehalogenase, wherein A is  $(CH_2)_n$  and n = 2-10 4-10, wherein X is a halogen, and wherein R is a biotin functional group coupled through its carboxy terminus to the linker; and
- b) detecting or determining the presence or amount of the functional group, thereby detecting or determining the presence or amount of the mutant <u>dehalogenase</u> hydrolase.

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- 36. (Withdrawn, Currently Amended) The method of claim 35 wherein the substitution is at a residue in the wild-type hydrolase dehalogenase that activates the water molecule.
- 37. (Withdrawn, Currently Amended) The method of claim 36 wherein the residue in the wild-type hydrolase dehalogenase that activates the water molecule is histidine.
- 38. (Withdrawn, Currently Amended) The method of claim 35 wherein the substitution is at a residue in the wild-type <a href="hydrolase">hydrolase</a> dehalogenase that forms an ester intermediate with the substrate.
- 39. (Withdrawn, Currently Amended) The method of claim 38 wherein the residue in the wild-type hydrolase dehalogenase that forms an ester intermediate with the substrate is aspartate.
- 40. (Withdrawn, Currently Amended) A method to isolate a molecule, cell or subcellular organelle of interest in a sample, comprising:
  - a) contacting a sample with a fusion protein comprising a mutant hydrolase and a hydrolase substrate which comprises one or more functional groups, wherein the mutant hydrolase comprises at least one amino acid substitution relative to a corresponding wild-type hydrolase, wherein the at least one amino acid substitution results in the mutant hydrolase forming a bond with the substrate which is more stable than the bond formed between the corresponding wild-type hydrolase and the substrate, wherein the at least one amino acid substitution in the mutant hydrolase is a substitution at an amino acid residue in the corresponding wild-type hydrolase that is associated with activating a water molecule which cleaves the bond formed between the corresponding wild-type hydrolase and the substrate or at an amino acid residue in the corresponding wild-type hydrolase that forms an ester intermediate with the substrate, wherein the fusion protein comprises a protein which binds a molecule, cell or subcellular organelle of interest, wherein the wild-type hydrolase is a dehalogenase, wherein the mutant hydrolase is a mutant dehalogenase, and wherein the substrate is a compound of formula (I): R-linker-A-X,

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wherein the linker is a divalent branched or unbranched carbon chain comprising from about 2 to about 30 carbon atoms, which chain optionally includes one or more double or triple bonds, and which chain is optionally substituted with one or more hydroxy or oxo (=O) groups, wherein one or more of the carbon atoms in the chain is optionally replaced with a non-peroxide -O-, -S- or -NH-, wherein the linker-A separates R and X by at least 11 atoms, wherein A-X is a substrate for a dehalogenase, wherein A is  $(CH_2)_n$  and n = 2-  $10 \ 4$ -10, wherein X is a halogen, and wherein R is a biotin functional group coupled through its carboxy terminus to the linker; and

- b) isolating the molecule, cell or subcellular organelle of interest.
- 41. (Withdrawn, Currently Amended) The method of claim 40 wherein the substitution is at a residue in the wild-type hydrolase dehalogenase that activates the water molecule.
- 42. (Withdrawn, Currently Amended) The method of claim 41 wherein the residue in the wild-type <a href="hydrolase">hydrolase</a> dehalogenase that activates the water molecule is histidine.
- 43. (Withdrawn, Currently Amended) The method of claim 40 wherein the substitution is at a residue in the wild-type hydrolase dehalogenase that forms an ester intermediate with the substrate.
- 44. (Withdrawn, Currently Amended) The method of claim 43 wherein the residue in the wild-type hydrolase dehalogenase that forms an ester intermediate with the substrate is aspartate.
- 45. (Canceled)
- 46. (Withdrawn) The method of claim 40 wherein the molecule of interest is a protein.
- 47. (Withdrawn, Currently Amended) A method to label a cell, comprising:

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- a) contacting a cell comprising a mutant hydrolase with a hydrolase substrate which comprises one or more functional groups, wherein the mutant hydrolase comprises at least one amino acid substitution relative to a corresponding wild-type hydrolase, wherein the at least one amino acid substitution results in the mutant hydrolase forming a bond with the substrate which is more stable than the bond formed between the corresponding wild-type hydrolase and the substrate, wherein the at least one amino acid substitution in the mutant hydrolase is a substitution at an amino acid residue in the corresponding wildtype hydrolase that is associated with activating a water molecule which cleaves a bond formed between the corresponding wild-type hydrolase and the substrate or at an amino acid residue in the corresponding wild-type hydrolase that forms an ester intermediate with the substrate, wherein the wild-type hydrolase is a dehalogenase, wherein the mutant hydrolase is a mutant dehalogenase, and wherein the substrate is a compound of formula (I): R-linker-A-X, wherein the linker is a divalent branched or unbranched carbon chain comprising from about 2 to about 30 carbon atoms, which chain optionally includes one or more double or triple bonds, and which chain is optionally substituted with one or more hydroxy or oxo (=O) groups, wherein one or more of the carbon atoms in the chain is optionally replaced with a non-peroxide -O-, -S- or -NH-, wherein the linker-A separates R and X by at least 11 atoms, wherein A-X is a substrate for a dehalogenase, wherein A is  $(CH_2)_n$  and n = 2-10 4-10, wherein X is a halogen, and wherein R is a biotin functional group coupled through its carboxy terminus to the linker; and b) detecting or determining the presence or amount of the functional group.
- 48. (Withdrawn, Currently Amended) The method of claim 47 wherein the substitution is at a residue in the wild-type <u>hydrolase</u> <u>dehalogenase</u> that activates the water molecule.
- 49. (Withdrawn, Currently Amended) The method of claim 48 wherein the residue in the wild-type <a href="hydrolase">hydrolase</a> dehalogenas that activates the water molecule is histidine.

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- 50. (Withdrawn, Currently Amended) The method of claim 47 wherein the substitution is at a residue in the wild-type hydrolase dehalogenase that forms an ester intermediate with the substrate.
- 51. (Withdrawn, Currently Amended) The method of claim 50 wherein the residue in the wild-type hydrolase dehalogenase that forms an ester intermediate with the substrate is aspartate.
- 52-54. (Canceled)
- 55. (Withdrawn, Currently Amended) The method of claim  $\frac{52}{35}$ ,  $\frac{35}{40}$  or  $\frac{47}{40}$  wherein the linker comprises (CH<sub>2</sub>CH<sub>2</sub>)<sub>v</sub> and y = 2-8.
- 56. (Withdrawn, Previously Presented) The method of claim 52 35, 40 or 47 wherein the linker separates R and A by at least 12 atoms.
- 57. (Canceled)
- 58. (Withdrawn, Currently Amended) The method of any one of claims 35, 40 or 47 wherein the mutant <u>hydrolase</u> <u>dehalogenase</u> is present in a cell or on the surface of a cell.
- 59-63. (Canceled)
- 64. (Withdrawn, Currently Amended) The method of any one of claims 35, 40 or 47 wherein the presence of at least one functional group in a cell is correlated to the subcellular location of the mutant <a href="https://hydrolase.com/hydrolase">hydrolase</a> dehalogenase.
- 65. (Withdrawn, Currently Amended) The method of any one of claims 35, 40 or 47 wherein the mutant hydrolase dehalogenase further comprises a protein of interest, thereby yielding a fusion protein.

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66. (Withdrawn) The method of claim 65 wherein the protein of interest is a selectable marker protein, membrane protein, cytosolic protein, nuclear protein, structural protein, an enzyme, an enzyme substrate, a receptor protein, a transporter protein, a transcription factor, a channel protein, a phospho-protein, a kinase, a signaling protein, a metabolic protein, a mitochondrial protein, a receptor associated protein, a nucleic acid binding protein, an extracellular matrix protein, a secreted protein, a receptor ligand, a serum protein, an immunogenic protein, a fluorescent protein, or a protein with reactive cysteine.

- 67. (Withdrawn, Currently Amended) The method of claim 47 wherein the mutant hydrolase dehalogenase further comprises a selectable marker protein.
- 68. (Canceled)
- 69. (Withdrawn, Currently Amended) The method of claim 68 67 wherein the mutant hydrolase dehalogenase forms an ester bond with the substrate.
- 70. (Withdrawn, Currently Amended) The method of claim 68 67 wherein the mutant hydrolase dehalogenase forms a thioester bond with the substrate.
- 71. (Withdrawn) The method of claim 47 further comprising contacting the cell with a fixative prior to or after contacting the cell with the substrate.
- 72. (Withdrawn) The method of claim 47 further comprising contacting the cell with a fixative concurrently with contacting the cell with the substrate.
- 73. (Withdrawn) The method of claim 71 or 72 wherein the cell is fixed with methanol, acetone and/or paraformaldehyde.

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- 74. (Withdrawn) The method of claim 67 further comprising contacting the cell with a fixative prior to or after contacting the cell with the substrate.
- 75. (Withdrawn) The method of claim 67 further comprising contacting the cell with a fixative concurrently contacting the cell with the substrate.
- 76. (Withdrawn) The method of claim 74 or 75 wherein the cell is fixed with methanol, acetone and/or paraformaldehyde.
- 77. (Withdrawn) The method of claim 52 wherein the mutant dehalogenase is encoded by a nucleic acid sequence which is optimized for expression in a selected host cell.

78-106. (Canceled)

107. (Currently Amended) A method for preparing a compound of formula R-Linker-A-X comprising coupling a compound of formula R-Y with a compound of formula Z-Linker-A-X, wherein Y and Z are groups that can react to link R- to –Linker-A-X, wherein the linker is a divalent branched or unbranched carbon chain comprising from about 2 to about 30 carbon atoms, which chain optionally includes one or more double or triple bonds, and which chain is optionally substituted with one or more hydroxy or oxo (=O) groups, wherein one or more of the carbon atoms in the chain is optionally replaced with a non-peroxide -O-, -S- or -NH-, wherein the linker-A separates R and X by at least 11 atoms, wherein A-X is a substrate for a dehalogenase, wherein A is (CH<sub>2</sub>)<sub>n</sub> and n = 2-10 4-10, wherein X is a halogen, and wherein R is a biotin functional group that is capable of being coupled through its carboxy terminus to the linker, and wherein R-Y is an activated ester of a compound of formula R and wherein Z is an amine suitable to react with the activated ester to form an amide bond.

108. (Canceled)

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- 109. (Original) A method for preparing a compound of formula R-Linker-A-X wherein the Linker comprises an amide bond comprising coupling a corresponding activated ester with a corresponding amine to provide the compound of formula R-Linker-A-X.
- 110. (Currently Amended) The compound of claim 1 A compound of formula (I): R-linker-A-X, wherein R is one or more functional groups, wherein the linker is a divalent branched or unbranched carbon chain comprising from 2 to 30 carbon atoms, which chain optionally includes one or more double or triple bonds, and which chain is optionally substituted with one or more hydroxy or oxo (=0) groups, wherein one or more of the carbon atoms in the chain is optionally replaced with a non-peroxide -O-, -S- or -NH-, wherein the linker-A separates R and X by at least 11 atoms, wherein A is  $(CH_2)_n$  and n =2-10, wherein A-X is a substrate for a dehalogenase, and wherein X is a halogen, wherein R is a biotin functional group coupled through its carboxy terminus to the linker.
- 111. (Previously Presented) The compound of claim 110 which is a substrate for a Rhodococcus dehalogenase.
- 112. (Previously Presented) The compound of claim 110 wherein X is Cl or Br.
- 113. (Previously Presented) The compound of claim 110 wherein the linker comprises 3 to 30 atoms.
- 114. (Previously Presented) The compound of claim 110 wherein the linker has 11 to 30 atoms.
- 115. (Previously Presented) The compound of claim 110 which is N-{2-[2-(6-Chlorohexyloxy)-ethoxy]-ethyl}-biotin-amide.
- 116. (Previously Presented) The compound of claim 110 wherein R is separated from A-X by up to 100 angstroms.

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- 117. (Previously Presented) The compound of claim 110 wherein R is separated from A-X by up to 500 angstroms.
- 118. (Previously Presented) The compound of claim 110 wherein the chain comprises  $(CH_2CH_2O)_y$  and y = 2-8.
- 119. (Previously Presented) A compound prepared by the method of claim 107 wherein the compound is

$$R \stackrel{O}{\downarrow}_{H} \stackrel{O}{\checkmark}_{O} \stackrel{O}{\checkmark}_{O} \stackrel{C}{\checkmark}_{O}$$

120. (Currently Amended) A compound of formula (I): R-linker-A-X, wherein R is one or more functional groups, wherein the linker is a divalent branched or unbranched carbon chain comprising from about 2 to about 30 carbon atoms, which chain optionally includes one or more double or triple bonds, and which chain is optionally substituted with one or more hydroxy or oxo (=O) groups, wherein one or more of the carbon atoms in the chain is optionally replaced with a non-peroxide -O-, -S- or -NH-, wherein the linker-A separates R and X by at least 11 atoms, wherein A is (CH<sub>2</sub>)<sub>n</sub> and n = 2-10, wherein A-X is a substrate for a dehalogenase, wherein X is a halogen, and wherein R is a biotin functional group coupled through its carboxy terminus to the linker.